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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,632	10/01/2001	Andre Santos Lessa	011280	2275
23464	7590	12/08/2004	EXAMINER	
BUCHANAN INGERSOLL, P.C. ONE OXFORD CENTRE, 301 GRANT STREET 20TH FLOOR PITTSBURGH, PA 15219			BLAIR, DOUGLAS B	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/682,632	LESSA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Douglas B Blair	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 October 2001.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/14/2002.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 12 recites the limitation "said informing step" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 9-13, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,618,747 to Flynn et al..
6. As to claim 1, Flynn teaches a method for tracing an email message comprising the steps of: providing a server able to communicate with a first computer system from which a first email message is sent by a sender and with a second computer system from which said first email

message is received by a recipient (col. 5, lines 10-40); receiving said first email message sent by said sender for said recipient (col. 5, lines 10-40); sending a second email message to said recipient (col. 5, lines 10-40); detecting when said recipient opens said second email message and informing said sender that said recipient has opened said second email message (col. 5, line 46-col. 6, line 8).

7. As to claim 2, Flynn teaches the method of claim 1 further comprising the step of modifying said first email message to create said second email message (col. 5, lines 10-40).

8. As to claim 3, Flynn teaches the method of claim 2 wherein said modification causes said second computer system to search for a file on said server when said recipient opens said second email message (col. 5, line 46-col. 6, line 8).

9. As to claim 4, Flynn teaches the method of claim 3 wherein said modification causes said second computer system to search for a file on said serve wherein said recipient opens said second email message (col. 5, line 46-col. 6, line 8).

10. As to claim 9, Flynn teaches the method of claim 1, further comprising the steps of: storing on said server the email address of said sender of said first email message (col. 5, lines 10-40); creating a unique identification code (col. 5, lines 10-40); associating said unique identification code with said email address of said sender; and including said unique identification code with said second email message (col. 5, lines 10-40).

11. As to claim 10, Flynn teaches the method of claim 9 further comprising the step of waiting to receive a request from said second computer system said request in some way containing said unique identification code (col. 5, line 46-col. 6, line 8).

12. As to claim 11, Flynn teaches the method of claim 10 further comprising the steps of: retrieving said sender's email address through said association with said received unique identification code (col. 6, lines 9-21); and information said sender that said recipient has opened said second email message (col. 6, lines 9-21).

13. As to claim 12, Flynn teaches the method of claim 1 wherein an informing step comprises the step of sending a third email message to said sender (col. 5, line 46-col. 6, line 8).

14. As to claim 13, Flynn teaches the method of claim 12 wherein said third email message includes the date and time that said recipient opened said second email message (col. 5, line 46-col. 6, line 8).

15. As to claim 16, Flynn teaches the method of claim 1 further comprising the steps of: storing said first email message on said server; and creating said second email message, said second email message containing a link to said stored first email message (col. 5, lines 10-40).

16. As to claim 17, Flynn teaches the method of claim 16, wherein said second email message contains instructions for said recipient to access said stored first email message by selecting said included link (col. 5, lines 10-40).

17. As to claim 18, Flynn teaches the method of claim 17 further comprising the steps of: detecting when said stored first email message is requested by said second computer system (col. 5, line 46-col. 6, line 8); and using said request as an indication that said recipient has opened said second email message (col. 5, line 46-col. 6, line 8).

18. As to claims 19 and 20, they are rejected for the same reasons as claims 16-18.

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 14-15, 21-23 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,618,747 to Flynn et al. in view of U.S. Patent Number 6,360,221 to Gough et al..

21. As to claim 14, Flynn teaches the method of claim 1; however Flynn does not teach posting a notification on a web site.

Gough teaches posting a notification on a website (col. 7, lines 62-col 8, lines 9)

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Flynn regarding email receipts with the teachings of Gough regarding posting a notification on a web site because web based email system are cheaper (Gough, col. 1, lines 36-51).

22. As to claim 15, it is rejected for the same reason as claim 13.

23. As to claim 21, Flynn teaches a method for tracing an email message comprising the steps of: providing a server having an interface accessible as a web page; allowing a sender of an email message to access the server to compose a first email message for recipient on a computer system with which said server is able to communicate (col. 5, lines 10-40); sending a second email message to said recipient (col. 5, lines 10-40); detecting when said recipient opens said second email message; and informing said sender that said recipient has opened said second

email message (col. 5, line 46-col. 6, line 8); however Flynn does not explicitly teach accessing the server via the web page interface to compose an email message.

Gough teaches accessing a server via the web page interface to compose an email message (col. 4, line 22-col. 5, line 14).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Flynn regarding email receipts with the teachings of Gough regarding accessing a server via the web page interface to compose an email message because web based email system are cheaper (Gough, col. 1, lines 36-51).

24. As to claims 22 and 23, they are rejected for the same reasons as claims 2-4.
25. As to claim 25, Flynn teaches detecting a request from a second computer system and suing the request as an indication that a recipient has opened a second email message (col. 5, line 46-col. 6, line 8).
26. As to claims 26-30, they are rejected for the same reasons as claims 16-20.
27. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,618,747 to Flynn et al. in view of U.S. Patent Number 6,826,594 to Pettersen.
28. As to claim 5, Flynn teaches the method of claim 4, however Flynn does not explicitly teach the use of the image tag.

Pettersen teaches the use of the <IMG> command (col. 8, lines 6-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Flynn regarding email receipts with the teachings of Pettersen regarding the use of the <IMG> command because the image tag is useful for conveying information (Pettersen, col. 8, lines 6-42).

29. As to claim 6, Pettersen teaches the <IMG> command causing a second computer system to execute a script (col. 8, lines 6-42).

30. As to claim 7, Flynn teaches detecting a request from a second computer system and suing the request as an indication that a recipient has opened a second email message (col. 5, line 46-col. 6, line 8).

31. As to claim 8, Pettersen teaches a method wherein the <IMG> command causes a second computer system to search for an image file on a server, further comprising the steps of: detecting the request from said second computer system for an image file (col. 8, lines 6-42); using a request as an indication that a recipient has opened a second email message (col. 8, lines 6-42); and sending a dummy image file to a second computer system in response to a request (col. 8, lines 6-42).

32. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,618,747 to Flynn et al. in view of U.S. Patent Number 6,360,221 to Gough et al. in further view of U.S. Patent Number 6,826,594 to Pettersen.

33. As to claim 24, the Flynn-Gough combination teaches the method of claim 23, however the Flynn-Gough combination does not explicitly teach the use of the image tag.

Pettersen teaches the use of the <IMG> command (col. 8, lines 6-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Flynn-Gough combination regarding email receipts with the teachings of Pettersen regarding the use of the <IMG> command because the image tag is useful for conveying information (Pettersen, col. 8, lines 6-42).

***Conclusion***

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

*DBB*

*Julie*  
JASON CARPONE  
PRIMARY EXAMINER  
AU: 2145